



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-1801100
<b>Complainant:</b>	BASF SE
<b>Respondent:</b>	Sergey Makarov
<b>Disputed Domain Name(s):</b>	basf-polyurea.com

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**1. The Parties and Contested Domain Name**

The Complainant is BASF SE, which address is Carl-Bosch Strasse Ludwigshafen, Germany.

The Respondent is Sergey Makarov, whose address is 10-59 Tevosyana St., Elektrostal, Moscow region, 144012.

The domain name at issue is <basf-polyurea.com> (the “Domain Name”). The Domain Name is registered by Respondent with REG.RU LLC, passage Berezovoy Roshchi, 12, Suite 4, Moscow, 125252, Russia.

**2. Procedural History**

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Center”) on April 17, 2018. On April 18, 2018, the Center transmitted by email to REG.RU LLC a request for registrar verification for the Domain Name. On April 19, 2018, REG.RU LLC transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint and disclosing that the language of the Registration Agreement is Russian.

The Center sent an email communication to the Complainant on April 20, 2018 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Center also informed the Complainant about a failure to attach registration agreement for the Domain Name to the Complaint. On April 20, 2018, the Complainant submitted the amended Complaint along with the registration agreement.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from 31 July 2015 (the “Supplemental Rules”).

Under Paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 25, 2018. Under Paragraph 5 of the Rules, the due date for filing a Response by the Respondent was May 15, 2018. The Respondent submitted no response by this deadline date.

The Complaint was submitted in the English language. The language of the Registration Agreement for the Domain Name is Russian. In its April 25, 2018, the Center notified the Parties in English and Russian about the language of the proceeding and informed the Respondent that the Complainant requested that English be the language of the proceeding and that the Respondent may respond to the Complainant’s request. The Respondent did not comment on the language of the proceeding.

The Center appointed Olga Zalomiy as the sole panelist in this matter on May 31, 2018. The Panel finds it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7. The Panel is proficient in both the English and the Russian languages.

### **3. Factual background**

The Complainant is a German chemical company, which owns the well-known BASF trademark. Among others, the Complainant owns the following trademark registrations:

- BASF, international registration No. 638794 of May 3, 1995, designating many countries worldwide, including China, where the Respondent is located, covering goods in classes 3, 5 and 30;
- BASF, international registration No. 909293 of October 31, 2006, designating many countries worldwide, including China, where the Respondent is located, covering goods and services in classes 1, 2, 3, 4, 5, 6, 7, 9, 10, 12, 16, 17, 18, 19, 22, 24, 25, 27, 28, 29, 30, 31, 32, 35, 36, 37, 39, 41, 42 and 44.

The Respondent is an individual named Sergey Makarov. The Respondent registered the Domain Name on November 14, 2017. The Domain Name does not resolve to any active websites.

### **4. Parties’ Contentions**

#### **A. Complainant**

The Complainant’s contentions may be summarized as follows:

- i. The Complainant asserts that the Domain Name is identical and/or confusingly similar to the BASF trademark in which the Complainant has rights. The

Complainant contends that the Domain Name is identical to the BASF trademark and is likely to create confusion in the mind of the general public. The Complainant argues that the use of lower case letter format and the addition of the word "polyurea" are not significant in determining whether the Domain Name is identical or confusingly similar to the mark. Instead, the Complainant contends that the confusion between the Domain Name and the Complainant's mark is enhanced by the addition of the work "polyurea", because the word's meaning is strictly related to chemicals, which are the Complainant's main product.

- ii. The Complainant alleges that the Respondent has no rights or legitimate interests in the Domain Name. The Complainant alleges the Respondent is not commonly known by the Domain Name and has acquired no trademark or service mark rights related to the "BASF" term. The Complainant claims that the Respondent's use of the Domain Name or preparation to use the Domain Name demonstrates no intent to use it in connection with a *bona fide* offering of goods or services because the Domain Name has not been used in any way whatsoever. To the best of the Complainant's knowledge, the Respondent has not intended or made preparations to use the Domain Name in connection with a *bona fide* offering of goods or services. The Complainant claims that it has never granted to the Respondent authorization, license or any right whatsoever to use the Complainant's BASF trademark. The Complainant contends that the Respondent is not commercially linked to the Complainant.
- iii. The Complainant asserts that the Domain Name has been registered and is being used by the Respondent in bad faith. The Complainant alleges that the Respondent knew about the Complainant's trademark when he registered the Domain Name, because the Complainant's BASF trademark is well-known. The Complainant argues that there is no possible way whatsoever that the Respondent would use the Domain Name in connection with a *bona fide* offering of products or services because any use of the BASF trademark would amount to trademark infringement and damage to the reputation of the Complainant's trademark. The Complainant contends that the Respondent registered the Domain Name to prevent the Complainant from reflecting its trademark and company name in the Domain Name, which is a strong evidence of bad faith. The Complainant alleges that the Respondent uses a well-known privacy service in order to keep its identity secret. The Complainant contends that while use of such service not actionable per se, is a further evidence of bad faith registration and use.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

## 5. Findings

### 5.1. Language of the proceeding

Under Paragraph 11 of the Rules, "Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

Because there is no evidence on file showing that the Parties agreed otherwise and because the language of the Registration Agreement is Russian, the default language of the administrative proceeding shall be Russian. However, the Complainant requested that the language of the proceeding be English because the Complainant was not able to communicate in Russian. Making the Complainant, a German entity, to go through the expense of the translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceeding and the adjudication of this matter. The Complainant claims that the Respondent, however, understands English because the Domain Name contains the English word “polyurea”.

Previous UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. “Such scenarios include ... (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant’s mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, ... (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint...”

The Panel finds that under the circumstances of this case English is an appropriate the language of this proceeding. Specifically, the Panel finds that it is likely that the Respondent understands English. The evidence on file shows that the Respondent registered the Domain Name, which contains the Complainant’s trademark and the English word “polyurea”, which is material used in the Complainant’s products. Taken together, all parts of the the Domain Name show that the Respondent likely understands English. In addition, the Center notified the Parties in both Russian and English of the potential language issue, providing the Respondent with an opportunity to comment on or object to any such language request that may be made by the Complainant. However, the Respondent did not object to the Complainant’s request for English to be the language of this administrative proceeding. Therefore, the Panel finds that it will not be unfair to the Respondent if the proceeding is conducted in English. Instead, forcing the Complainant to translate the Complaint and supporting documents into Russian will impose undue financial burden on the Complainant and delay resolution of the dispute.

## 5.2. Standard of review

It is a consensus view among UDRP panelists that “[a] respondent's default does not automatically result in a decision in favor of the complainant... [T]he complainant must establish each of the three elements required by paragraph 4(a) of the UDRP.”<sup>1</sup> A panel may draw inferences from a respondent's default.<sup>2</sup>

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and

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<sup>1</sup> Paragraph 4.2., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)

<sup>2</sup> Paragraph 4.3., WIPO Overview 3.0.

- iii. Respondent's domain name has been registered and is being used in bad faith.

#### **A) Identical / Confusingly Similar**

To satisfy the first UDRP element, a domain name must be "identical or confusingly similar" to a trademark, in which a complainant has rights.

The Complainant has established his rights in the BASF trademark by submitting copies of trademark registrations. Pursuant to section 1.2.1 of the WIPO Overview 3.0, "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

It is well established that the test for confusing similarity under the first UDRP element "typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name." "Where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." "Where trademark is recognizable within the disputed domain name, the addition of other terms ... would not prevent finding of confusing similarity."

Here, the Domain Name consists of the Complainant's BASF trademark, the generic word "polyurea", a hyphen and the generic Top-Level Domain ("gTLD") suffix ".com". A side-by-side comparison of the Domain Name shows that the Domain Name incorporates the Complainant's trademark in its entirety and the BASF trademark is easily recognizable in the Domain Name. As a result, neither the addition of the word "polyurea", nor the addition of the hyphen, prevents finding of confusing similarity. The addition of the gTLD ".com" is disregarded under the confusing similarity test.

Thus, the Domain Name is identical or confusingly similar to the Complainant's BASF mark and the first element of the UDRP has been satisfied.

#### **B) Rights or Legitimate Interests**

Under the second UDRP element, a complainant must make a *prima facie* case in respect of the lack of rights or legitimate interests of the respondent. Once the complainant has made out the *prima facie* case, the respondent carries the burden of producing evidence demonstrating it has rights or legitimate interests in the domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name because the Complainant has not authorized the Respondent to use and register the Complainant's BASF trademark or to register any domain names incorporating the BASF mark. Previous UDRP panels have found that in the absence of any license or permission from a complainant to use a complainant's trademarks, generally no *bona fide* or legitimate use of the domain name could reasonably be claimed. See,

*LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master, WIPO Case No. D2010 -0138.*

The Complainant claims that the Respondent is not commonly known by the Domain Name, which evinces a lack of rights or legitimate interests. See UDRP, paragraph 4(c)(ii). The Respondent's name, "Sergey Makarov", does not resemble the Domain Name in any manner – thus, there is no evidence that suggests that the Respondent is commonly known by the Domain Name. In addition, because the Respondent used a privacy shield to conceal his identity, the Respondent cannot have been commonly known by the Domain Name. See, *L'Oréal SA v. PrivacyProtect.org/ WangShanShan*, WIPO Case No. D2014-0295 ("there is no evidence that the Respondent, who is moreover hiding behind a privacy shield, has been commonly known by the Domain Name.")

Moreover, the record shows that the Respondent is not making a legitimate noncommercial or fair use of the Domain Name. The Domain Name does not resolve to any developed website and does not appear to have done so. There is no evidence of the Respondent's use or preparations to use that Domain Name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial purpose.

The Panel therefore finds that the Complainant has made out a *prima facie* case in respect to the Respondent's lack of rights or legitimate interests in the Domain Name. Since the Respondent has failed to rebut the Complainant's case, the Panel holds that the second element of the UDRP has been satisfied.

### **C) Bad Faith**

Under the third UDRP element, the Complainant is required to prove that the Domain Name was registered and is being used in bad faith.

The Panel finds that the Respondent registered the Domain Name in bad faith because at the time of the Domain Name registration he was aware of the Complainant and its BASF trademark. Previous UDRP panels found that "the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."<sup>3</sup> Here, the Respondent registered the Domain Name comprising of the Complainant's trademark BASF, the generic word "polyurea" and a hyphen together with the gTLD ".com. The BASF trademark has been found to be well-known by many previous UDRP panels. See, *BASF SE v. jing liu/liujing*, WIPO Case No. D2014-1889; *BASF SE v. WhoisGuard Protected, WhoisGuard, Inc. / Haibin Yu*, WIPO Case No. D2017-2400; *BASF SE v. zhanfeng guo, guozhanfeng*, WIPO Case No. D2016-2260; *BASF SE v. Hee Chowming*, WIPO Case No. D2017-0021; *BASF SE v. Henning Krogh, Krogh Invest*, WIPO Case No. D2017-2220. Such registration shows Respondent's knowledge of the Complainant's mark and creates a presumption of bad faith registration.

Although the Domain Name does not point to any developed website, it does not prevent finding of bad faith. "[P]anelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding"<sup>4</sup>. In similar situations, UDRP panelists look into the totality of

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<sup>3</sup> Paragraph 3.1.4., WIPO Overview 3.0.

<sup>4</sup> Paragraph 3.3., WIPO Overview 3.0.

circumstances in a specific case, including the following: “(i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”<sup>5</sup>

The totality of circumstances in this case shows it is more likely than not that the Respondent is using the Domain Name in bad faith. First, the Complainant’s trademark is well-known. Second, the Respondent did not respond to these Complainant’s allegations and did not submit any evidence helping to identify its intended use of the Domain Name. Third, the Respondent concealed its identity at the time of the registration. Fourth, the Panel finds any good faith use of the Domain Name implausible. Based on the totality of evidence, the Panel concludes that the Respondent registered and is using the Domain Name in bad faith.

The Panel finds that the Complainant has made out the requirements of paragraph 4(a)(iii) of the UDRP.

## **6. Decision**

Under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <basf-polyurea.com> be transferred to the Complainant.

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Olga Zalomiy  
Sole Panelist

Dated: June 11, 2018

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<sup>5</sup> *Id.*